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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,016	09/20/2001	Alain Gantier	P21432	3081
7055	7590	12/29/2003		
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
			EXAMINER MÔHANDESI, JILA M	
			ART UNIT 3728	PAPER NUMBER 13
DATE MAILED: 12/29/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/937,016

Applicant(s)

GANTIER, ALAIN

Examiner

Jila M Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 10, 2003 has been entered.

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 30, the specification does not provide proper antecedent basis for the phrase "upper front zone", "upper rear zone", and "said device .....including an intermediate part, an upper part, and a lower part".

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 recites the limitation "said end zone of said upper" in line 12". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. It is noted that the term “snowboard boot” in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.

7. Claims 14-18 and 20-23, 25-26, 28-29, 35-42 and 44-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellis (3,206,874). Ellis '874 discloses an assembly comprising: a shoe and a device (foot protector 34 with guard flap 36) for flexural stiffening and/or protection of the shoe; said shoe having a flexion fold zone (the location of the flexion fold zone is dependent on the type and size of the shoe and will vary from one type of a shoe to another), an upper front surface, a front end zone, said device including a cover covering said upper front surface of said shoe and extending from said flexion fold zone of said shoe to said front end zone of said shoe.

With respect to claims 16, 17, 20-22, 37, 38, 46 and 47, note the journal connection/insert (hinge 40 and plate 38) in Figures 1 and 2 embodiments.

With respect to claim 23, the insert (40 & 38) is on opposite sides of said sole.

With regard to claims 25 and 45 and the material of the cover, see column 3, lines 2-6.

With regard to claim 26 and the immobilizing means, note the rivet (45) in Figures 1 and 2 embodiments.

Contrary to applicant's argument the device of Ellis '874 does not interfere with the flexing of the shoe. The loop fastener in combination with the hinge allows for the movement/flexing of the device and does not interfere with the flexing of the shoe.

8. Claims 14-18 and 20-22, 25-26, 28-29, 35-42 and 44-47 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Donnell (3,068,593). O'Donnell '593 discloses an assembly comprising: a shoe and a device (foot protector flap 32) for flexural stiffening and/or protection of the shoe; said shoe having a flexion fold zone (the location of the flexion fold zone is dependent on the type and size of the shoe and will vary from one type of a shoe to another), an upper front surface, a front end zone, said device including a cover covering said upper front surface of said shoe and extending from said flexion fold zone of said shoe to said front end zone of said shoe.

With respect to claims 16, 17, 20-22, 37, 38, 46 and 47, note the journal connection/insert (furrules 31 and studs 36) in Figures 1-4 embodiments.

With regard to claims 25 and 45 and the material of the cover, see column 2, lines 27-29.

With regard to claim 26 and the immobilizing means, note the screw (41) in Figures 1-4 embodiments.

Contrary to applicant's argument the device of O'Donnell '593 does not interfere with the flexing of the shoe. The loop fastener in combination with the pivotal faster

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allows for movement/flexing of the device and therefore does not interfere with the flexing of the shoe.

9. Claims 14-15, 18, 19, 20, 22, 26, 28, 29, 30, 31, 33, 37 38, 39, 40, 41, 42, 44 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Edwards et al.

(3,334,427). Edwards discloses an assembly comprising: an article of footwear and a device (22 & 32) for increasing flexural rigidity and protection of the article of footwear; said article of footwear including an upper and a sole, said upper including a flexion fold zone, an upper front zone and an upper rear zone; said upper front zone of said upper being contiguous with and extending above said flexion fold zone in an upward direction to adapt the upper front zone to be positioned forward of a lower leg of a wearer of the article of footwear; said upper rear zone of said upper extending in said upward direction to adapt the upper rear zone to be positioned rearward of the lower leg of the wearer of the article of footwear; a front end zone of said upper extending in a direction forward of said flexion fold zone; said device for increasing flexural rigidity and protection of the article of footwear comprising a cover having three parts, said three parts including an intermediate part, an upper part, and a lower part; said intermediate part of said cover covering said flexion fold zone of said article of footwear; said lower part of said cover extending forwardly from said intermediate part of said cover along an area above said front end zone of said article of footwear; said upper part of said cover extending upwardly from said intermediate part of said cover along an area in front of said upper front zone of said upper of said article of footwear, said upper part of said

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cover extending substantially in said upward direction of the front and rear zones of said upper of said article of footwear. See Figures 1-5 embodiments.

With respect to claim 33, note the tightening strap/lace in Figure 3 embodiment.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 27, 43 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis '874. Ellis '874 discloses that the cover can be made of different materials which inherently will have different rigidity. (see column 3, lines 2-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a plurality of covers made from different materials having varying rigidities, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

12. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis '874 in view of ETABLISSEMENTS JACQUES LANDRY (FR 2 361 837). Ellis '874 as described above discloses all the limitations of the claims except for the device including tightening straps. LANDRY discloses an assembly comprising: a shoe and a device (2) for flexural stiffening and/or protection of the shoe; said device comprising tightening straps for better securing the device to the shoe. Therefore, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to provide tightening straps to the device of Ellis `874 as taught by LANDRY to better secure the device to the shoe.

13. Claims 19 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis `874 in view of Edwards `427. Ellis `874 as described above discloses all the limitations of the claims except for the device extending from a tibial support zone to a metatarsophalangeal articulation zone. Edwards `427 discloses that it is desirable to have a device extending from a tibial support zone to a metatarsophalangeal articulation zone to give better protection to this area of the boot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of Ellis `874 extend from a tibial support zone to a metatarsophalangeal articulation zone as taught by Edwards `427 to provide better protection for this area of the boot.

14. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell `593 in view of ETABLISSEMENTS JACQUES LANDRY (FR 2 361 837). Ellis `874 as described above discloses all the limitations of the claims except for the device including tightening straps and the specifics of the size of the device. LANDRY discloses an assembly comprising: a shoe and a device (2) for flexural stiffening and/or protection of the shoe; said device comprising tightening straps for better securing the device to the shoe. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide tightening straps to



the device of O'Donnell '593 as taught by LANDRY to better secure the device to the shoe.

15. Claims 19 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell '593 in view of Edwards '427. O'Donnell '593 as described above discloses all the limitations of the claims except for the device extending from a tibial support zone to a metatarsophalangeal articulation zone. Edwards '427 discloses that it is desirable to have a device extending from a tibial support zone to a metatarsophalangeal articulation zone to give better protection to this area of the boot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of O'Donnell '593 extend from a tibial support zone to a metatarsophalangeal articulation zone as taught by Edwards '427 to provide better protection for this area of the boot.

16. Claims 16, 17, 21, 23, 24, 25, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards '427 in view of Ellis 874. Edwards '427 discloses that the device may be fastened to the article of footwear by any suitable means. Ellis '874 discloses a journal connection for connecting the device to the sole of the shoe. Accordingly, the skilled artisan would have been motivated to substitute the flexible hinge of Edwards '427 for the journal connection of Ellis '874 insofar as they are art-recognized equivalents.

17. Claims 27, 43 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards '427. Edwards '427 discloses that the cover can be made of different materials, which inherently will have different rigidity. (see column 3, lines 2-6).

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Therefor, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a plurality of covers made from different materials having varying rigidities, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

***Allowable Subject Matter***

**18.** Claim 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**19.** The indicated allowability of claim 23 is withdrawn after further review and consideration of the admitted prior art.

***Response to Arguments***

**20.** Applicant's arguments filed May 07, 2003 have been fully considered but they are not persuasive. Contrary to applicant's argument the device of O'Donnell '593 and O'Donnell '593 do not interfere with the flexing of the shoe. The loop fastener in combination with the hinge/pivotal fastener allows for the movement/swivel of the device and does not interfere with the flexing of the shoe.

***Conclusion***

**21.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**22.** Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information "should be directed to the group

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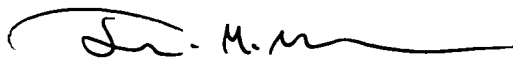
clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner cannot confirm receipt of faxes) Please identify Examiner Mohandesi of Art Unit 3728 at the top of your cover sheet of any correspondence submitted. Inquiries only concerning the merits of the examination should be directed to Jila Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.

Check out our web-site at "www.uspto.gov" for fees and other useful information.

**JILA M. MOHANDESI  
PRIMARY EXAMINER**

  
Jila M Mohandesi  
Primary Examiner  
Art Unit 3728

JMM  
December 18, 2003